

## REMARKS

### I. Status of Claims

Claims 120-125 are pending in this application. No claims have been amended herein. Applicants filed a Supplemental Preliminary Amendment on March 18, 2005, canceling the then-pending claims and adding new claims 120-125. That paper was not considered by the Office prior to the issuance of the April 5, 2005, Office Action. Therefore, although the Office has examined and rejected now-canceled claims 104-119, Applicants will traverse the rejections to the extent the Office might choose to maintain them against current claims 120-125.

### II. Rejection under 35 U.S.C. § 112, First Paragraph

Claims 104-108 and 112-115 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. The Office objects to Applicants' claim language providing that  $R^4$  may be "a direct bond to at least one group chosen from  $R^3$  and another  $R^4$  such that when said at least one group is chosen from another  $R^4$ , the nitrogen atom to which both  $R^3$  and  $R^4$  are bonded forms part of a heterocyclic structure defined in part by  $R^4-N-R^3$ ." According to the Office, "[t]here is no description in the specification for heterocyclic ring systems," as "[t]he expression could encompass a myriad of compounds and applicants' claimed expression represents only an invitation to experiment regarding possible heterocyclic compounds." Office Action at pp. 2-3. Applicants respectfully traverse the rejection to the extent it might be applied against claims 120-125.

Possession is the cornerstone of the written description requirement: "the test for compliance with § 112 has always required sufficient information in the original disclosure to show that the inventor possessed the invention at the time of the original filing." *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1320 (Fed. Cir. 2003). An applicant can show possession by pointing out adequate or sufficient description for the claims in the original specification, as would be understood by one of ordinary skill in the art. See MPEP § 2163(I). Furthermore, possession can be demonstrated by reference to a properly incorporated U.S. patent. See 37 C.F.R. § 1.57(c) and MPEP § 608.01(p) (both stating that information to fulfill the written description requirement may be properly incorporated by reference from a U.S. patent). Thus, support in the originally filed specification, including via incorporation by reference, necessarily shows that the inventor had possession of the claimed subject matter at the time the original application was filed.

The instant specification clearly contains sufficient support for heterocyclic structures and ring systems in at least the paragraphs beginning on page 10 through the fourth full paragraph on page 11. Specifically, the first full paragraph on page 10 explains that the  $R^4$  group of formula (I) is chosen from one of a hydrogen atom, a  $C_1$  to  $C_{10}$  alkyl group, and direct bonds to another group chosen from  $R^3$  and another  $R^4$ . The paragraph further explains that when the  $R^4$  group is a direct bond, heterocyclic ring systems are possible that are defined in part by  $R^4$ -N- $R^3$ . Moreover, that paragraph specifically incorporates by reference U.S. Patent No. 5,783,657 ("the '657 patent") for when the at least one heteropolymer is at least one polyamide polymer of formula (I).

The '657 patent, in at least column 6, line 9 to column 7, line 14, clearly describes to one of ordinary skill in the art the heterocyclic ring systems and structures possible with the  $R^4$  groups of formula (I), including that  $R^4$  may be a direct bond to at least one group chosen from  $R^3$  and another  $R^4$  such that when said at least one group is chosen from another  $R^4$ , the nitrogen atom to which both  $R^3$  and  $R^4$  are bonded forms part of a heterocyclic structure defined in part by  $R^4$ -N- $R^3$ . See, e.g., '657 patent, column 4, lines 40-43<sup>1</sup>. In light of the description in the paragraphs beginning on page 10 through the fourth full paragraph on page 11 of the application, taken together with the disclosure of the '657 patent which is properly incorporated by reference, Applicants assert that the recitation of heterocyclic structures for the  $R^4$  groups of formula (I) has adequate support in the original specification to satisfy the written description requirement.

Further, the Office states that the expression at issue could encompass "myriad" compounds and is only an "invitation to experiment." Office Action at p. 3. Applicants do not deny that the claim is broad; however, as explained above, the broad subject matter is adequately described and that description satisfies the written description requirement.

Regarding the Office's "invitation to experiment" comment, the Office has not pointed to any evidence establishing that the polymers at issue are so unpredictable that one skilled in the art would have any trouble envisioning the breadth that Applicants describe. There is therefore no basis of record to support the Office's apparent

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<sup>1</sup> Applicants note for the Office's convenience that in the '657 patent,  $R^4$  is referred to as  $R^{3a}$ .

conclusion that Applicants did not possess the invention as claimed but merely invited others to experiment to achieve that invention.

Accordingly, the rejection is improper and should not be applied to claims 120-125.

**III. Rejection under 35 U.S.C. § 112, Second Paragraph**

Claims 106, 110, and 114 were rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite because “[t]he claims recite one compound and yet the claims are in Markush group format.” Office Action at p. 3. Applicants disagree. Claims 106, 110, and 114, however, have been canceled, and the Office’s rejection is therefore moot. Furthermore, that rejection does not apply to claims 120-125.

**IV. Rejection under 35 U.S.C. § 103**

Claims 104-108 and 112-115 were rejected under 35 U.S.C. § 103 as allegedly obvious over U.S. Patent Nos. 5,783,657 to Pavlin et al. (“Pavlin”) and 6,214,329 to Brieva et al. (“Brieva”). According to the Office, Pavlin teaches all of the elements of the present claims with the exception that Pavlin “does not teach the specific volatile solvent or preservatives.” Office Action at p. 5. The Office attempts to rectify this deficiency by relying on Brieva as teaching a “mascara product using [the] specific volatile oil claimed . . . .” *Id.*

Thus, the Office apparently concludes that combining Pavlin with the elements taught in Brieva would have been obvious to one of ordinary skill in the art “for having been used in the same [m]ascara art,” and because “when this product is applied to eyelashes the polymer imparts glossy and non-migrating benefit and the non-migrating

benefit is useful to the consumer because when the [m]ascara is applied to eyelashes it does not stick to hands [and] clothing.” *Id.* Applicants disagree and respectfully traverse the rejection to the extent it might be applied to claims 120-125.

To establish a prima facie case of obviousness, the Office must, among other things, establish that the motivation or suggestion to combine the references exists in the knowledge of those skilled in the art or in the references themselves. See M.P.E.P. § 2143. Applicants respectfully submit that the Office has not done so under the present circumstances with respect to the combination of Pavlin and Brieva, for at least the following reasons.

The Office admits that Pavlin does not teach isododecane, as recited in all of the instant claims. Thus, the Office looks to Brieva as teaching, among other things, isododecane. According to the present Office Action, “[t]he motivation to combine the ingredients flows logically [from] the art for having been used in the same [m]ascara art.” Office Action at pp. 5-6. Applicants disagree with that overly broad characterization of motivation. If the Office were correct, any and all mascara teachings could be combined, rendering unpatentable forevermore any combination of old mascara ingredients.

The overbreadth of the Office’s alleged motivation ignores chemical compatibility and formulating realities, and is evident upon examining the teachings of the references themselves. In particular, Brieva actually teaches away from incorporating a polymeric gelling agent, such as the polyamide disclosed in Pavlin, into the composition. Brieva emphasizes throughout the disclosure that the composition includes a “non-polymeric

gelling agent.” In contrast, the polyamide of Pavlin, being, of course, a polymer by definition, is the very type of polymeric gelling agent Brieva clearly teaches against by emphasizing non-polymeric gelling agents. This not a case where Brieva does not specify whether the gelling agent is polymeric or non-polymeric or states that either can be used. Rather, he explicitly only teaches exclusively the non-polymeric variety. That is the case even though Brieva’s assignee, Revlon, is a sophisticated and significant player in the mascara market.

Moreover, almost a year elapsed between Pavlin’s issuance and the filing of Brieva. Thus, while at the very least the polymeric gelling polyamide of Pavlin was known in the art at the time Brieva was filed, Brieva nonetheless specifically recited only the use of a non-polymeric gelling agent. One sees, therefore, that Brieva went to great lengths to emphasize that the gelling agent incorporated therein is non-polymeric, despite the polymeric gelling agents known in the art. So, if it wasn’t obvious to Brieva to include known polymeric gelling agents in his compositions, why would it have been obvious to one skilled in the art at the time of the present invention to so modify Brieva?

Applicants therefore respectfully submit that one of ordinary skill in the art would not have been motivated to combine the polyamide polymer of Pavlin with Brieva, a reference that goes to great length to emphasize that the gelling agent incorporated therein is non-polymeric. In sum, that which teaches away cannot, by definition, provide the necessary motivation to combine that is required to establish a rejection under 35 U.S.C. § 103: “It is improper to combine references where the references teach away from their combination.” M.P.E.P. § 2145 X.2. Nothing in the record provides any

reason why one would have been motivated to modify a reference that uses only non-polymeric gelling agents with a polymeric gelling agent.

Furthermore, the Office has not even addressed, and thus has pointed to no reason, why one of skill in the art would have been motivated to extract the isododecane disclosed in Brieva and use it in the compositions of Pavlin. Therefore, the rejection is improper and Applicants respectfully request that it not be applied to new claims 120-125.

**V. Rejections under 35 U.S.C. § 102(e)**

Claims 104-119 were provisionally rejected under 35 U.S.C. § 102(e) as allegedly anticipated by copending Application Nos. 09/618,066 ("the '066 application") and 09/685,577 ("the '577 application"). Applicants respectfully traverse the rejection to the extent it might be applied to claims 120-125.

Applicants disagree with the Office that either the '066 application or the '577 application anticipates the present claims. The '066 and '577 applications cannot anticipate the currently pending claims drawn to a method of making up eyelashes comprising applying to said eyelashes a mascara comprising at least five specific elements as a matter of law. For a reference to be anticipatory under 35 U.S.C. § 102 it must "clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without any need for picking, choosing, and combining various disclosures...." *In re Arkley*, 455 F.2d 586 (CCPA 1972) 587. Thus, simply because the '066 and '577 applications disclose, at different points throughout, a method of making up eyelashes and various other elements of the currently pending claims, some

of which are disclosed to be optional, does not mean that the '066 and '577 applications are anticipatory.

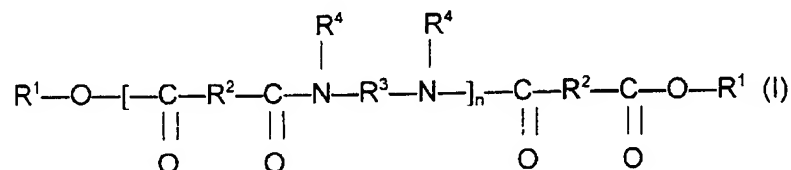
If that kind of shotgun disclosure were the standard for anticipation, listings of formulations and chemicals found in any cosmetic dictionary or handbook would anticipate any composition that combines ingredients individually listed in the cosmetic dictionary or handbook, regardless of whether such a specific formulation had ever been made. In other words, no cosmetic composition comprising known ingredients could possibly be novel. That sweeping conclusion, which would severely limit cosmetic research to the pursuit of new ingredients to incorporate into known cosmetic materials, would stand cosmetic research and development, as well as the law of anticipation under 35 U.S.C. § 102, on its head.

Furthermore, the overly broad approach taken by the Office is contrary to existing law (*see, e.g. Arkley, supra*) and cannot possibly accurately reflect the law of anticipation. For example, comparing the disclosures of the '066 and '577 applications to the present claims plainly shows that extensive picking and choosing among various disclosures therein, including picking and choosing among laundry lists of possible species in a genus and picking elements that are disclosed by the '066 and '577 applications as being only optionally included, would be required to arrive at the presently claimed invention. As an example, claim 120 as set forth in the Supplemental Preliminary Amendment reads:

120. A method of making up eyelashes comprising applying to said eyelashes a mascara comprising:



- (i) at least one solid substance that has a melting point of about 45°C or greater;
- (ii) isododecane;
- (iii) at least one structuring polymer chosen from polymers of following formula (I):



in which n is an integer which represents the number of amide units such that the number of ester groups present in said at least one structuring polymer ranges from 10% to 50% of the total number of all said ester groups and all said amide groups comprised in said at least one structuring polymer;

- R<sup>1</sup>, which are identical or different, are each chosen from alkyl groups with at least 4 carbon atoms and alkenyl groups with at least 4 carbon atoms;

- R<sup>2</sup>, which are identical or different, are each chosen from C<sub>4</sub> to C<sub>42</sub> hydrocarbon-based groups with the proviso that at least 50% of R<sup>2</sup> are chosen from C<sub>30</sub> to C<sub>42</sub> hydrocarbon-based groups;

- R<sup>3</sup>, which are identical or different, are each chosen from organic groups comprising atoms chosen from carbon atoms, hydrogen atoms, oxygen atoms and nitrogen atoms with the proviso that R<sup>3</sup> comprises at least 2 carbon atoms; and

- R<sup>4</sup>, which are identical or different, are each chosen from hydrogen atoms, C<sub>1</sub> to C<sub>10</sub> alkyl groups and a direct bond to at least one group chosen from R<sup>3</sup> and another R<sup>4</sup> such that when said at least one group is chosen from another R<sup>4</sup>, the nitrogen atom to which both



CLAIM ELEMENT IN APPLICATION NO. 10/787,441	LOCATION IN APPLICATION NO. 09/618,066 AND APPLICATION NO. 09/685,577
<p>(ii) isododecane;</p> <p>(iii) at least one structuring polymer chosen from polymers of formula (I);</p> <p>(iv) water;</p> <p>(v) at least one coloring agent; and</p> <p>(vi) at least one preservative.</p>	<p>optionally disclosed as being wax-free, thereby clearly conveying that the ingredient of wax is optional</p> <p>see page 19, lines 11 &amp; 18; please note that isododecane is one of many oils that can be useful for the liquid fatty phase; the list spans almost two pages (page 18, line 2 to page 19, line 18), and includes an untold number of compounds</p> <p>see page 10, line 13 to page 11, line 20; please note that the polyamide polymer of formula (I) is one of numerous structuring polymers useful according to the present invention; the description of the structuring polymers according to the present invention spans almost 8 pages (page 6, line 10 to page 14, line 4)</p> <p>optional additive at page 20, lines 2-3</p> <p>throughout: see, e.g., page 1, lines 1-5; page 3, line 12 to page 4, line 2; page 22, lines 3-9; see also page 22, line 18 to page 24, line 8 (also see examples)</p> <p>optional additive at page 20, line 4</p>

Thus, as can be clearly seen from the above table, the ingredients which are all recited together in one composition used in the method of making up eyelashes of claim 120 of the present application are distributed randomly throughout the '066 and '577 applications as optional ingredients or as one of a laundry list of possible compounds that may satisfy a particular element of those cases, and as such, extensive picking and choosing would be required for one of skill in the art to have arrived at the presently claimed invention.

Such prohibited picking and choosing, however, cannot satisfy the court's test for anticipation as set forth in *Arkley, supra*. Therefore, the Office's provisional rejection under 35 U.S.C. § 102(e) over the '066 and '577 applications is improper, and Applicants respectfully request that it not be applied to current claims 120-125.

#### **VI. Copending Applications**

In the Amendments filed on February 27, 2004, and March 18, 2005, in this case, Applicants noted in Table 3 information regarding a total of 41 copending applications, including the present application, and submitted copies of the pending claims as of that date for every case identified in Table 3. In the following Table 3, Applicants have noted one additional application that has been filed, and enclose herewith in Exhibit 1 a copy of the copending claims for the additional case. Furthermore, Applicants submit herewith also in Exhibit 1 copies of the currently pending claims from the following copending applications, which claims have been amended since March 18, 2005: 09/733,896; 09/749,036; 10/413,217; 10/699,780; 10/046,568; and 10/746,612. The

submission is intended to allow the Office to make its own independent evaluation of whether any issue exists regarding statutory or obviousness-type double patenting.

**Table 3**

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date/ 371 (c) Date	Inventors	Title	Assignment Recorded (Reel, Frame, Date)	Publication, Date
06028.0047-00000	10/494,864	May 7, 2004	Didier CANDAU and Christèle GOMBERT	COMPOSITION CONTAINING AN AMINO ACID N-ACYLATED ESTER AND A POLYAMIDE-STRUCTURED UV FILTER	Not yet recorded	Not yet published

## VII. Conclusion

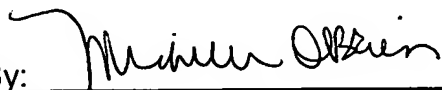
In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: July 5, 2005

By:   
Michelle E. O'Brien  
Reg. No. 46,203

## Attachments:

**Exhibit 1 -** Pending Claims in Copending Applications and Patents

**Exhibit 1**  
Pending Claims in Copending Applications